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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
09/915,438	07/26/2001	Rabindranath Dutta	AUS920010422US1	7369

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INTERNATIONAL BUSINESS MACHINES CORPORATION
c/o BIGGERS & OHANIAN, LLP
504 LAVACA STREET, SUITE 970
AUSTIN, TX 78701-2856

EXAMINER

O CONNOR, GERALD J

ART UNIT	PAPER NUMBER
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3627

DATE MAILED: 06/01/2005

Please find below and/or attached an Office communication concerning this application or proceeding.

Office Action Summary

Application No.

09/915,438

Applicant(s)

Dutta et al.

Examiner

O'Connor

Art Unit

3627

– The MAILING DATE of this communication appears on the cover sheet with the correspondence address –

Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE THREE MONTH(S) FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If the period for reply specified above is less than thirty (30) days, a reply within the statutory minimum of thirty (30) days will be considered timely.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

Status

- 1) ☒ Responsive to communication(s) filed on March 8, 2005.
- 2a) ☒ This action is **FINAL**. 2b) ☐ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

Disposition of Claims

- 4) ☒ Claim(s) 1-60 is/are pending in the application.
- 4a) Of the above claim(s) 21-60 is/are withdrawn from consideration.
- 5) ☐ Claim(s) _____ is/are allowed.
- 6) ☒ Claim(s) 1-20 is/are rejected.
- 7) ☐ Claim(s) _____ is/are objected to.
- 8) ☐ Claim(s) _____ are subject to restriction and/or election requirement.

Application Papers

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☐ The drawing(s) filed on _____ is/are: a) ☐ accepted or b) ☐ objected to by the Examiner.
Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).
Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
- 11) ☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

Priority under 35 U.S.C. § 119

- 12) ☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☐ All b) ☐ Some * c) ☐ None of:
- ☐ Certified copies of the priority documents have been received.
 - ☐ Certified copies of the priority documents have been received in Application No. _____.
 - ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).

* See the attached detailed Office action for a list of the certified copies not received.

Attachment(s)

- | | |
|--|---|
| 1) <input type="checkbox"/> Notice of References Cited (PTO-892) | 4) <input type="checkbox"/> Interview Summary (PTO-413)
Paper No(s)/Mail Date. _____ |
| 2) <input type="checkbox"/> Notice of Draftsperson's Patent Drawing Review (PTO-948) | 5) <input type="checkbox"/> Notice of Informal Patent Application (PTO-152) |
| 3) <input type="checkbox"/> Information Disclosure Statement(s) (PTO-1449 or PTO/SB/08)
Paper No(s)/Mail Date _____ | 6) <input type="checkbox"/> Other: _____ |

DETAILED ACTION

Preliminary Remarks

1. This Office action responds to the amendment and arguments filed by applicant on March 8, 2005 in reply to the previous Office action, mailed December 9, 2004.
2. The amendment of claims 5, 15, 16, and 18 by applicant in the reply filed March 8, 2005 is hereby acknowledged.

Election/Restriction

3. This application contains claims 21-60 drawn to an invention non-elected with traverse in the reply filed August 17, 2004. A complete reply to this final rejection must include cancellation of non-elected claims or other appropriate action (37 CFR 1.144). See MPEP § 821.01.

Claim Rejections - 35 USC § 103

4. The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

(a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negated by the manner in which the invention was made.

5. Claims 1-6 and 11-20 are rejected under 35 U.S.C. 103(a) as being unpatentable over Pool et al. (US 6,460,020).

Regarding claims 1, 2, 12, and 13, Pool et al. disclose a method for facilitating customs planning and clearance, the method comprising the steps of: creating a master customs planning record and a related customs planning record in at least one international customs server, in response to signals communicated through a client device coupled for data communications through at least one Internet connection to the at least one international customs server, and the method of Pool et al. includes, either inherently or explicitly, calculating and storing all of the recited data elements that the claimed master customs planning record and related customs planning record comprise, but Pool et al. do not specifically disclose that the respective customs planning records each individually comprise all of the specific data elements, as claimed. However, it would have been obvious to one of ordinary skill in the art, at the time of the invention, to have arranged any of the calculated and stored data elements of Pool et al. so as to be stored in the specific arrangement/manner of the instant claims, simply as a matter of design choice, since so doing could have been performed readily and easily by any person of ordinary skill in the art, with neither undue experimentation, nor risk of unexpected results.

Regarding claim 3, each related customs planning record of the method of Pool et al. represents a prospective importation into a destination country of a quantity of goods of a category.

Regarding claims 4-6, the method of Pool et al. further comprises creating, in dependence upon the related customs planning record, a customs declaration form for a destination country, submitting the form to a customs declaration forms database for the destination country, and submitting, to the customs service of the destination country, payment of the duty.

Regarding claim 11, Pool et al. disclose that the at least one Internet connection can be wireless.

Regarding claim 14, the method of Pool et al. further comprises that the international customs server is a software application installed and operating on one or more computers, the software application further comprising software routines storing and retrieving related customs planning records, validating goods described in related customs planning records against customs regulations stored in customs regulations databases, and submitting to customs databases declaration forms prepared in dependence upon the related customs planning records.

Regarding claim 15, the method of Pool et al. includes that creating in dependence upon the related customs planning record a customs declaration form for the destination country further comprises reading customs data from a related customs planning record and inserting the read customs data into a declaration form.

Regarding claim 16, the method of Pool et al. further includes that submitting the customs declaration form to a customs declaration forms database for the destination country further comprises communicating the form as electronic data communications through at least one Internet connection.

Regarding claim 17, the method of Pool et al. further comprises validating goods described in a related customs planning record by comparing the goods described by customs data in the related customs planning record to customs regulations governing the goods described by the customs data in the related customs planning record, storing the result of the comparison in the related customs planning record, and reporting to an importer through the client device a result of the comparison.

Regarding claim 20, the method of Pool et al. further comprises that the related customs planning record comprises a related customs planning record form having a structure, wherein the structure of the related customs planning record form is dependent upon customs regulations.

6. Claims 7-10 are rejected under 35 U.S.C. 103(a) as being unpatentable over Pool et al. as applied to claim 1 above, and further in view of Seigel et al. (US 2001/0051876).

Pool et al. disclose a method for facilitating customs planning and clearance, as applied above to claim 1, but Pool et al. fail to disclose the client device as specifically being any of: a workstation in a kiosk at an airport; a workstation installed in the back of a passenger chair in an airplane; a personal computer; or, a hand-held personal data administrator (PDA).

However, Seigel et al. disclose a similar method that also requires accessing the Internet, as does the method of Pool et al., and the method of Seigel et al. specifically discloses that the client device used to access the Internet can indeed be any of: a workstation in a kiosk at an airport; a workstation installed in the back of a passenger chair in an airplane; a personal

computer; or, a hand-held personal data administrator (PDA). See, in particular, paragraphs 16 and 60-62.

Therefore, it would have been obvious to one of ordinary skill in the art, at the time of the invention, to have modified the method of Pool et al. so as to use a client device comprising any of a workstation in a kiosk at an airport; a workstation installed in the back of a passenger chair in an airplane; a personal computer; or, a hand-held personal data administrator (PDA), in accordance with the teachings of Seigel et al., in order to provide easy and convenient access to the Internet.

Response to Arguments

7. Applicant's arguments filed March 8, 2005 have been fully considered but they are not persuasive.

8. Regarding the argument that the rejection is based on well known prior art according to MPEP § 2144.03, the rejection is not based on well known prior art according to MPEP § 2144.03. The rejection is based on design choice, which is to say that, while the method of Pool et al. includes, either inherently or explicitly, calculating and storing all of the recited data elements that the claimed master customs planning record and related customs planning record comprise, the method of Pool et al. is not disclosed as having the respective customs planning records each individually comprise all of the respective data elements, as claimed by applicant. However, because there is nothing special (non-obvious) about storing the information in a data

structure such as that of applicant's claimed invention, as compared to storing the same information in a different data structure/arrangement, such as disclosed by Pool et al., the difference is considered obvious (non-patentably distinct) to one of ordinary skill in the art, because one of ordinary skill in the art would be readily and easily able to make the change, with neither undue experimentation, nor risk of unexpected results, which is the main test for obviousness/non-obviousness.

9. Regarding the argument that the Pool et al. reference is too complex and shows too many other inventions for applicant to understand, the disclosure of Pool et al. is directly on point with respect to applicant's invention, and is considered neither complex nor lengthy to those of ordinary skill in the art.

10. Regarding the argument that the invention of Pool et al. is a different invention than applicant's invention because the disclosure of Pool et al. fails to use the same names for certain elements as the names used by applicant, the argument is irrelevant, as it is noted that the disclosure in a reference must show the claimed elements arranged in the same manner as in the claims, but need not be in the identical words as used in the claims in order to be anticipatory. See *In re Bond*, 15 USPQ2d 1566 (Fed. Cir. 1990).

11. Regarding the argument *vis-à-vis* inherency, the disclosure in a reference can be either explicit or inherent. Elements are considered inherent when they are *necessarily* present. In this case, the invention of Pool et al. could not perform as disclosed without knowing/determining all of the recited elements of data/information. Therefore, the elements are indeed properly considered inherent.

12. Regarding the argument that there is no suggestion to modify the reference, the examiner recognizes that obviousness can only be established by combining or modifying the teachings of the prior art to produce the claimed invention where there is some teaching, suggestion, or motivation to do so found either in the references themselves or in the knowledge generally available to one of ordinary skill in the art. See *In re Fine*, 837 F.2d 1071, 5 USPQ2d 1596 (Fed. Cir. 1988) and *In re Jones*, 958 F.2d 347, 21 USPQ2d 1941 (Fed. Cir. 1992). In this case, the motivation to modify the prior art would be found in the knowledge generally available to one of ordinary skill in the art.

13. Regarding the argument that Pool et al. teaches away from the instant invention, the disclosure of Pool et al. does not teach away from the instant invention because the disclosure of Pool et al. discloses, in all respects, the exact same invention as claimed by applicant except for not explicitly disclosing storing the same elements of information/data in the exact same manner/arrangement as applicant. See, for example, the abstract.

14. Regarding the remarks by applicant purporting to “reserve the right to petition the Commissioner for review of the restriction requirement,” the remarks have been noted. However, applicant is advised that no such reservation of such a right is permitted under the rules. In fact, to be seasonable, hence, even considered, any such petition must be filed within two months of any such requirement being made final, and in any event, before any further action/reply by applicant. See, for example, 37 CFR 1.181(f). Therefore, as no such reservation is permitted, the statement has been deemed merely spurious, hence, disregarded.

Conclusion

15. The prior art made of record and not relied upon is considered pertinent to the disclosure.

16. **THIS ACTION IS MADE FINAL.** Applicant is reminded of the extension of time policy as set forth in 37 CFR 1.136(a).

A shortened statutory period for reply to this final action is set to expire **THREE MONTHS** from the mailing date of this action. In the event a first reply is filed within **TWO MONTHS** of the mailing date of this final action and the advisory action is not mailed until after the end of the **THREE-MONTH** shortened statutory period, then the shortened statutory period will expire on the date the advisory action is mailed, and any extension fee pursuant to 37 CFR 1.136(a) will be calculated from the mailing date of the advisory action. In no event, however, will the statutory period for reply expire later than **SIX MONTHS** from the mailing date of this final action.

17. Any inquiry concerning this communication, or earlier communications, should be directed to the examiner, **Jerry O'Connor**, whose telephone number is **(571) 272-6787**, and whose facsimile number is **(571) 273-6787**.

The examiner can normally be reached weekdays from 9:30 to 6:00.

If attempts to reach the examiner are unsuccessful, the examiner's supervisor, Mr. Robert Olszewski, can be reached at **(571) 272-6788**.

Official replies to this Office action may be submitted by any *one* of fax, mail, or hand delivery. **Faxed replies are preferred and should be directed to (703) 872-9306**. Mailed replies should be addressed to "Commissioner for Patents, PO Box 1450, Alexandria, VA 22313-1450." Hand delivered replies should be delivered to the "Customer Service Window, Randolph Building, 401 Dulany Street, Alexandria, VA 22314."

GJOC

May 25, 2005



Gerald J. O'Connor
Primary Examiner
Group Art Unit 3627